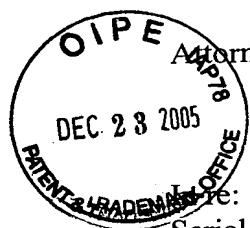


37 § 6
D A C



Attorney Docket No. 9099-2IP

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Scarantino et al.

Conf. No.: 1156

Serial No.: 10/089,483

Group: 3736

Filing Date: September 17, 2002

Examiner: Michael C. Astorino

For: **METHODS, COMPUTER PROGRAM PRODUCTS, AND DEVICES FOR
CALIBRATING CHRONICALLY TISSUE IMPLANTED SENSORS USING
CHRONICALLY TISSUE IMPLANTED GENERATING ELECTRODES**

Date: December 21, 2005

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PETITION FOR WAIVER OF SIGNATURE
REQUIREMENTS UNDER 37 C.F.R. § 1.183 and/or § 1.47(a)

Sir:

This Request for Reconsideration of Petition is being filed responsive to the Decision on Petition (hereinafter "Decision") mailed October 24, 2005 from the United States Patent and Trademark Office (hereinafter "USPTO"). The Applicants hereby request reconsideration of the petition filed October 5, 2005 for the suspension of the signature requirements for Mr. Stefan Ufer under 37 C.F.R. § 1.183 and/or § 1.47 (hereinafter "Applicants' first petition") as Mr. Ufer has refused to sign the necessary papers such that the designation of inventorship in the above-identified patent application can be amended as requested in the Request for Correction of Inventorship under 37 C.F.R. § 1.48 that was filed with the USPTO on October 5, 2005. Additional Evidence in support of the suspension of rules/waiver of signature requirements is provided herein as requested in the Decision.

In particular, the Decision states that a grantable petition under § 1.47(a) requires five items and that Applicants' petition lacks (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); and (5) a statement of the last known address of the non-signing inventor.

With respect to item (1), Applicants provide herewith at Tab A a copy of a redacted email dated March 5, 2004 from Mr. Ufer confirming that Mr. Ufer received the application papers, reviewed the documents related to the application and agreed that he should be a named inventor in the above referenced application. In particular, the redacted email of March 5, 2004 at Tab A from Mr. Ufer to Ms. Sandy Mitofsky states that Mr. Ufer reviewed

In re: Scarantino et al.
Serial No. 10/089,483
Filed: September 17, 2002
Page 2

the documents related to 99-103 (North Carolina State University's (NCSU's) internal reference number) and agrees that he should be a named co-inventor on Attorney Docket No. 9099-2IP (corresponding to the instant application). Furthermore, as stated in Applicants' previous petition, Applicants' representative has forwarded the documents necessary to correct inventorship in the above referenced matter to Mr. Ufer for his signature on multiple occasions. An Assignment, a Declaration and a statement pursuant to 37 C.F.R. § 1.48 were forwarded to Mr. Ufer via Federal Express on June 24, 2004. *See* Letter from Elizabeth A. Stanek to Mr. Ufer on 6/24/04 at TAB A of Applicants' first petition. Even though Mr. Ufer is an employee of NCSU and under an obligation to assign to NCSU, the signed documents were not signed and returned by Mr. Ufer. Applicants' representative, Elizabeth A. Stanek, attempted to contact Mr. Ufer by telephone and email several times, but the documents were still not signed and returned. Finally, on November 5, 2004, the Assignment, Declaration and statement pursuant to 37 C.F.R. § 1.48 were again forwarded to Mr. Ufer for his signature. In the letter forwarding the documents, Mr. Ufer was warned that if he did not return the signed documents, Applicants' representative would proceed with changing the inventorship using procedures directed to dealing with an uncooperative inventor. *See* Letter from Elizabeth A. Stanek to Mr. Ufer on 11/5/04 at TAB B of Applicants' first petition.

Accordingly, Applicants respectfully submit that Mr. Ufer was presented with the application papers, agreed that he should be a named inventor on the above referenced application and has still refused to sign the necessary papers to obtain correction of inventorship in the above referenced matter.

With respect to item (5), the non-signing inventor's (Mr. Ufer's) last known address is:

41 South Swain
Raleigh, NC 27601;

as listed on the Declaration and Assignment, which he has not signed and returned. Applicants' representative has again forwarded a copy of the application papers, statement under 37 C.F.R. § 1.48, Assignment and Declaration to Mr. Ufer's last known address today, December 21, 2005, as requested in the Decision. A copy of the certified letter forwarding the papers to Mr. Ufer is attached hereto at Tab B.

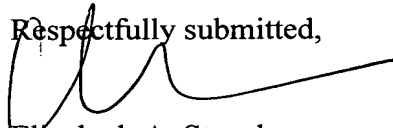
Applicants have provided herein the necessary items to satisfy items (1) and (5) for a grantable petition under 37 C.F.R. § 1.47(a) as requested by the Decision. Accordingly,

In re: Scarantino et al.
Serial No. 10/089,483
Filed: September 17, 2002
Page 3

Applicants respectfully request that the signature requirements for the statement pursuant to 37 C.F.R. § 1.48 with respect to lack of deceptive intent, the Assignment and the Declaration be waived so the proper inventorship may be on file in the above referenced application.

The petition fee was paid with the filing of Applicants' first petition. However, any additional fees or refunds associated with this transaction may be charged or overpayment credited to our Deposit Account No. 50-0220.

Respectfully submitted,



Elizabeth A. Stanek
Registration No. 48,568
Attorney for Applicants

Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, NC 27627
Tel (919) 854-1400
Fax (919) 854-1401

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 21, 2005.



Erin A. Campion

From: Stefan Ufer <sufer@email.unc.edu>
To: Sandy Mitofsky <smitofs@gw.fis.ncsu.edu>
Date: Fri, Mar 5, 2004 10:43 AM
Subject: Re: Your response to the 99-103 Inventorship Request

Sandy,

I reviewed the documents related to 99-103. I also had a phone conversation about this with Julie Richardson to clarify some of the questions I had.

- I agree with the conclusion reached during our last meeting that I am indeed a co-inventor for 9099-2IP
- I did not intellectually contribute to the claims of 90099-2CT/ 9099-2CT2 about radiation treatment and a sensor element generating radiation data.

Redacted

Please let me know, in case additional information from my side is needed in this matter.

Best Regards,

Stefan Ufer

The information transmitted is intended only for the person or entity to which it is addressed and may contain confidential and/or privileged material. Any review, retransmission, dissemination or other use of, or taking of any action in reliance upon, this information by persons or entities other than the intended recipient is prohibited. This document may contain information covered under the Privacy Act, 5 USC 552(a), and/or the Health Insurance Portability and Accountability Act (PL 104-191) and its various implementing regulations and must be protected in accordance with those provisions. If you received this in error, please contact the sender and delete the material from any computer.

On Wed, 3 Mar 2004, Sandy Mitofsky wrote:

> ** High Priority **
>

MYERS BIGEL SIBLEY & SAJOVEC, P.A.

PATENT LAWYERS

D. Randal Ayers	Anna R. Carr ¹	Shawna C. Lemon, Ph.D.	Julie H. Richardson
David D. Beatty	Robert N. Crouse	Karen A. Magri, Ph.D.	Rohan G. Sabapathypillai
Mitchell S. Bigel	Robert W. Glatz	Robert M. Meeks	F. Michael Sajovec
Needham J. Boddie, II	David C. Hall	Mary L. Miller, Ph.D.	Grant J. Scott
Alice M. Bonnen, Ph.D.	Scott C. Hatfield	D. Scott Moore	Kenneth D. Sibley
Lynne A. Borchers	Lori W. Herman, Ph.D.	James D. Myers	Elizabeth A. Stanek
James R. Cannon	Laura M. Kelley	David K. Purks	Richard P. Vitek

December 21, 2005

Via Certified Mail

Mr. Stefan Ufer
41 South Swain
Raleigh, NC 27601

Re: Inventorship: 9099-2 Family of Patents and Applications
Our Ref. Nos.: 9099-2IP

Dear Mr. Ufer:

Despite our repeated telephone and email messages to you on this topic and our prior letters of June 24, 2004 and November 5, 2004, we have not received the documents that were sent to you to implement the necessary changes to inventorship in the above referenced application. Accordingly, we are reforwarding to you with this letter the following documents:

1. a copy of the above-referenced application, preliminary amendment and figures;
2. an Assignment;
3. a Declaration and Power of Attorney; and
4. a Declaration In Support Of Petition For Correction Of Inventorship Under 37 CFR 1.48(a)

Items 2 through 4 are for your signature related to **adding** you as an inventor in the above-referenced application. Please sign each of these documents where indicated and return them to my attention by **January 9, 2006** using the enclosed Federal Express label. We appreciate your assistance with this matter. We recommend that you keep a signed copy for your records.

Please note that we have begun the process for changing the inventorship in the above-referenced application using procedures directed to dealing with an uncooperative inventor.

Please let us know if you have any questions.

Best regards.

Sincerely,


Elizabeth A. Stanek

EAS/eac
Enclosures